

ESTTA Tracking number: **ESTTA668705**

Filing date: **04/24/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92060895
Party	Plaintiff SIS Resources Ltd.
Correspondence Address	ANN K FORD DLA PIPER LLP (US) 500 8TH STREET NW WASHINGTON, DC 20004 UNITED STATES dctrade- marks@dlapiper.com, ann.ford@dlapiper.com, john.nading@dlapiper.com, ashley.joyce@dlapiper.com, al- berto.zacapa@dlapiper.com
Submission	Other Motions/Papers
Filer's Name	John M. Nading
Filer's e-mail	dctrade- marks@dlapiper.com,ann.ford@dlapiper.com,john.nading@dlapiper.com,ashley .joyce@dlapiper.com
Signature	/John M. Nading/
Date	04/24/2015
Attachments	Notice.pdf(2420551 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark
Registration No. 3619407
Mark: BLUE MIST
Filed: November 20, 2008
Registered: May 12, 2009

SIS RESOURCES LTD.,

Petitioner,

v.

STARBUZZ TOBACCO, INC.,

Registrant.

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Cancellation No. 92060895

**PETITIONER’S NOTICE TO THE UNITED STATES TRADEMARK TRIAL AND
APPEAL BOARD OF REGISTRANT’S IMPROPER PETITION TO DIRECTOR OF
THE UNITED STATES PATENT AND TRADEMARK OFFICE, AND
REQUEST FOR AN ORDER ADMONISHING REGISTRANT AND ORDERING THAT
THE PETITION TO DIRECTOR BE STRICKEN, REJECTED, OR WITHDRAWN**

Petitioner SIS Resources Ltd. (“Petitioner” or “SIS Resources”), by and through the undersigned counsel, files this Notice to the United States Trademark Trial and Appeal Board (“Board”) of Registrant Starbuzz Tobacco, Inc.’s (“Registrant” or “Starbuzz”) Improper Petition to Director of the United States Patent and Trademark Office (“USPTO”), which Starbuzz filed with the USPTO using the Trademark Electronic Application System (TEAS) on March 25, 2015 (“Petition to Director” or “Petition”). Attached hereto as Exhibit A is a true and correct copy of Registrant’s Petition to Director from TSDR on the USPTO website.

In its Petition to Director, Starbuzz asks the Commissioner to abandon Starbuzz’s declaration of incontestability for the BLUE MIST Mark Registration (U.S. Trademark Registration No. 3619407) (“Incontestability Declaration”) and remove the Section 15

designation from the registration; however, Starbuzz's fraudulently filed Incontestability Declaration for the BLUE MIST Mark Registration No. 3619407 ("BLUE MIST Mark Registration") is at the core of this Cancellation Proceeding. (*See, e.g.*, SIS Resources' Petition for Cancellation filed in this Proceeding on February 17, 2015.) Starbuzz is attempting to use a prosecution maneuver before the USPTO on an *ex parte* basis to circumvent the authority of the Board during the pendency of an *inter partes* proceeding before the Board. Specifically, Starbuzz is petitioning the Director for relief which could, if granted by the Director, dispositively resolve in Starbuzz's favor the very subject matter of this Cancellation. Not only is such a procedural maneuver highly improper according to the Code of Federal Regulations, the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), and the Trademark Manual of Examining Procedure ("TMEP"), as set forth below, but also it is highly improper that Starbuzz made no mention to the Director of this pending Cancellation Proceeding involving the very same issue, nor did Starbuzz serve a copy of the Petition to Director on the undersigned counsel or the Board. *See* 37 C.F.R. § 2.119.

Petitions to the Director in an *inter partes* proceeding are proper only when there is an (a) order or decision of the Board, (b) that concerns a matter of procedure, not of substance, and (c) if granted by the Director, would ***not*** put an end to the litigation before the Board. *See* 37 C.F.R. § 2.146 (concerning petitions to the Director, including "to invoke the supervisory authority of the Director"); TBMP § 905 (discussing 37 C.F.R. § 2.146 and stating "**In an inter partes proceeding, a party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board), and does not put an end to the litigation before the Board, by timely petition to the Director.**") (emphasis added). *See also* TMEP § 1704 ("In an inter partes proceeding before the Trademark Trial and Appeal Board, a party may petition the Director to review an order or decision of the

Board that concerns a matter of procedure and does not put an end to the litigation before the Board.”).¹

Here, there is no order or decision of the Board at issue in this Cancellation Proceeding, the Petition to Director is substantive and not procedural, and, if the Director were to grant the requested relief in the Petition to Director, it could be in effect a dispositive finding by the Director in this Proceeding and put an end to this Cancellation Proceeding. This is not a situation where the Director is being asked to exercise supervisory authority; to the contrary, the relief requested of the Director is the very matter substantively at issue in this pending Cancellation Proceeding before the Board.

Starbuzz’s Petition to Director is further evidence of Starbuzz’s fraudulent behavior in connection with the BLUE MIST Mark Registration. Starbuzz is once again playing fast and loose with its filings before the USPTO for the BLUE MIST Mark Registration that are not truthful nor in any way comprehensive or complete, so as to attempt to avoid having to defend against the claim of fraud, which is squarely before the Board in this Cancellation Proceeding. Tellingly, Starbuzz has conceded in its Petition to Director that its Incontestability Declaration at

¹ Though Starbuzz has invoked 37 C.F.R. § 2.146 to petition improperly the Director to abandon and remove the Incontestability Declaration for the BLUE MIST Mark Registration, Starbuzz is essentially asking the Director to amend the BLUE MIST Mark Registration without the consent of SIS Resources, the opposing party in a Board proceeding concerning the same BLUE MIST Mark Registration, and without Board approval, or on a motion granted by the Board. Amendment in this manner is improper as well. *See* 37 CFR § 2.133(a) (“An application subject to an opposition may not be amended in substance **nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board**”) (emphasis added); TBMP § 514.01 (“A **registration which is the subject of a Board inter partes proceeding may not be amended or the mark disclaimed in part, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board**”) (emphasis added); TMEP § 1609.01(b) (“**Requests to amend registrations are handled by the Post Registration Section, unless the registration is the subject of an inter partes proceeding before the Trademark Trial and Appeal Board.** 37 C.F.R. § 2.173(a).”) (emphasis added).

the least should not have been filed in the first place. The Petition to Director also shows that there are disputed issues of fact as to Starbuzz's intent in submitting its Incontestability Declaration while it was fully aware that its purported rights in the BLUE MIST Mark Registration were at issue in a pending federal litigation. Starbuzz's Petition to Director should not be allowed to stand to let Starbuzz bypass the Board's authority in this Cancellation Proceeding. SIS Resources seeks as its relief in this Proceeding cancellation of Starbuzz's entire BLUE MIST Mark Registration for fraud; thus, to allow Starbuzz to avoid litigation of the issue of Starbuzz's fraudulently filed Incontestability Declaration for the BLUE MIST Mark Registration would enable Starbuzz to circumvent due process before the Board and perpetuate Starbuzz's initial fraud upon the USPTO. Having been caught with its hand in the cookie jar, Starbuzz cannot seek to undo its actions by merely offering to return what it wrongfully took, namely, the fraudulent Incontestability Declaration. To the contrary, as pled in the Petition for Cancellation in this Proceeding, the proper relief for a fraudulently filed Incontestability Declaration is cancellation of the entire BLUE MIST Mark Registration.

Accordingly, SIS Resources respectfully requests that the Board issue an Order admonishing Starbuzz for filing its Petition to Director and directing that the Petition to Director be stricken, rejected, or withdrawn.

Dated: April 24, 2015

Respectfully submitted,

DLA PIPER LLP (US)

By: /s/ John M. Nading
Ann K. Ford
John M. Nading
Ashley H. Joyce
500 8th Street, NW
Washington, D.C. 20004
Tel. 202-799-4000
Fax 202-799-5000
Attorneys for Petitioner SIS Resources Ltd.

EXHIBIT A

2.146 petition to the Director

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77619104
REGISTRATION NUMBER	3619407
FORM TEXT	
<p>Dear Commissioner:</p> <p>This petition is a request to abandon Registrant, Starbuzz Tobacco, Inc.'s ("Starbuzz") declaration of incontestability for BLUE MIST (U.S. Trademark Registration No. 3,619,407), pursuant to Trademark Manual of Procedure § 1605.03 and 1707.</p> <p>Starbuzz's BLUE MIST mark was registered on May 12, 2009. Accordingly, the window for renewal under Section 8 of the Lanham Act opened on May 12, 2014. On May 23, 2014, Starbuzz filed a declaration of use and incontestability under Sections 8 and 15 of the Lanham Act. The Section 15 designation was inadvertently included, without any intent to deceive the USPTO or fraudulently obtain a registration or incontestable status. Accordingly, Starbuzz respectfully requests that the Director exercise supervisory authority, deem the Section 15 designation abandoned, and remove the designation from the BLUE MIST registration.</p> <p>Starbuzz believes that this request does not affect the validity of the registration, or the Section 8 declaration, because Section 15 incontestability relates to the right to use a mark, not the right to register. Regardless, Starbuzz respectfully requests the Director to enter a new Section 8 declaration, which is still timely since it is being filed between the fifth and sixth year after the date of registration. A true and correct copy of the Section 8 declaration is attached hereto as <u>Exhibit A</u>.</p> <p>Based upon the foregoing, Starbuzz respectfully requests the Director to remove the Section 15 designation from the registration and, if deemed necessary, renew the registration pursuant to Section 8 of the Lanham Act based upon the new declaration.</p> <p>Respectfully Submitted, <u>/natupatel/</u> Natu J. Patel Attorney for the Registrant, Starbuzz Tobacco, Inc.</p>	
ATTACHMENT(S)	

ORIGINAL PDF FILE	Exhibit A_20152257014749.PDF
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT16\IMAGEOUT16\776\191\77619104\xml6\PDR0002.jpg
	\\TICRS\EXPORT16\IMAGEOUT16\776\191\77619104\xml6\PDR0003.jpg
	\\TICRS\EXPORT16\IMAGEOUT16\776\191\77619104\xml6\PDR0004.jpg
	\\TICRS\EXPORT16\IMAGEOUT16\776\191\77619104\xml6\PDR0005.jpg
PAYMENT SECTION	
NUMBER OF CLASSES	1
FEE PER CLASS	100
NUMBER OF CLASSES	1
FEE PER CLASS	100
TOTAL FEES DUE	200
SIGNATURE SECTION	
DECLARATION SIGNATURE	/ghassanelsaadi/
SIGNATORY'S NAME	Ghassan ElSaadi
SIGNATORY'S POSITION	General Manager
DATE SIGNED	03/25/2015
SUBMISSION SIGNATURE	/natupatel/
SIGNATORY'S NAME	Natu J. Patel
SIGNATORY'S POSITION	Attorney, The Patel Law Firm, P.C., California Bar Member No. 188618
SIGNATORY'S PHONE NUMBER	(949) 955-1077
DATE SIGNED	03/25/2015
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
TEAS STAMP	USPTO/PDR-10.112.151.172- 20150325195214055430-3619 407-20150325185607839983- CC-5043-20150325185607839 983

2.146 petition to the Director
To the Commissioner for Trademarks:

The following is submitted for registration number. **3619407** :

FORM INFORMATION

Dear Commissioner:

This petition is a request to abandon Registrant, Starbuzz Tobacco, Inc.'s ("Starbuzz") declaration of incontestability for BLUE MIST (U.S. Trademark Registration No. 3,619,407), pursuant to Trademark Manual of Procedure § 1605.03 and 1707.

Starbuzz's BLUE MIST mark was registered on May 12, 2009. Accordingly, the window for renewal under Section 8 of the Lanham Act opened on May 12, 2014. On May 23, 2014, Starbuzz filed a declaration of use and incontestability under Sections 8 and 15 of the Lanham Act. The Section 15 designation was inadvertently included, without any intent to deceive the USPTO or fraudulently obtain a registration or incontestable status. Accordingly, Starbuzz respectfully requests that the Director exercise supervisory authority, deem the Section 15 designation abandoned, and remove the designation from the BLUE MIST registration.

Starbuzz believes that this request does not affect the validity of the registration, or the Section 8 declaration, because Section 15 incontestability relates to the right to use a mark, not the right to register. Regardless, Starbuzz respectfully requests the Director to enter a new Section 8 declaration, which is still timely since it is being filed between the fifth and sixth year after the date of registration. A true and correct copy of the Section 8 declaration is attached hereto as **Exhibit A**.

Based upon the foregoing, Starbuzz respectfully requests the Director to remove the Section 15 designation from the registration and, if deemed necessary, renew the registration pursuant to Section 8 of the Lanham Act based upon the new declaration.

Respectfully Submitted,
/natupatel/
Natu J. Patel
Attorney for the Registrant,
Starbuzz Tobacco, Inc.

FORM FILE NAME(S)

Original PDF file:

[Exhibit A_20152257014749.PDF](#)

Converted PDF file(s) (4 pages)

[Attachments-1](#)

[Attachments-2](#)

[Attachments-3](#)

[Attachments-4](#)

FEE(S)

Fee(s) in the amount of \$200 is being submitted.

SIGNATURE(S)

Declaration Signature

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth above are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Signature: /ghassanelsaadi/ Date: 03/25/2015

Signatory's Name: Ghassan ElSaadi

Signatory's Position: General Manager

Submission Signature

Signature: /natupatel/ Date: 03/25/2015

Signatory's Name: Natu J. Patel

Signatory's Position: Attorney, The Patel Law Firm, P.C., California Bar Member No. 188618

Signatory's Phone Number: (949) 955-1077

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the petitioner's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the petitioner in this matter: (1) the petitioner has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the petitioner has filed a power of attorney appointing him/her in this matter; or (4) the petitioner's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

RAM Sale Number: 5043

RAM Accounting Date: 03/26/2015

Serial Number: 77619104

Internet Transmission Date:

TEAS Stamp: USPTO/PDR-10.112.151.172-201503251952140

55430-3619407-20150325185607839983-CC-50

43-20150325185607839983

Exhibit A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark : BLUE MIST
Registration No. : 3,619,407
Registration Date : May 12, 2009
Registrant : Starbuzz Tobacco, Inc.

DECLARATION OF USE IN COMMERCE PURSUANT TO SECTION 8

Commissioner for Trademarks
PO Box 1451
Alexandria, VA 22313-1451

22952 Mill Creek Drive
Laguna Hills, CA 92653

Dear Commissioner:

The owner, Starbuzz Tobacco, Inc., having an address of 10871 Forbes Avenue, Garden Grove, California 92843, is filing a Declaration of Use under Section 8.

For International Class 34, the mark is in use in commerce on or in connection with all of the goods or services listed in the existing registration for this specific class:

“Pipe Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco, Molasses Tobacco.”

and the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with all goods or services listed in the existing registration for this class.

The owner is submitting one (or more) specimen(s) for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) picture of a can of BLUE MIST molasses tobacco.

DECLARATION

The mark is in use in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The mark has been in continuous use in commerce for five consecutive years after the date of registration, or the date of publication under 15 U.S.C. Section 1062(c), and is still in use in commerce on or in connection with all goods/services listed in the existing registration.

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The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Date

3/24/2015

By

Ghassan ElSaadi

Ghassan ElSaadi

General Manager

NP/JC/mu



CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing **PETITIONER'S NOTICE TO THE UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD OF REGISTRANT'S IMPROPER PETITION TO DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, AND REQUEST FOR AN ORDER ADMONISHING REGISTRANT AND ORDERING THAT THE PETITION TO DIRECTOR BE STRICKEN, REJECTED, OR WITHDRAWN** was served via First Class U.S. Mail, postage prepaid, and properly addressed to:

Starbuzz Tobacco, Inc.
10871 Forbes Ave
Garden Grove, California 92843

Natu J. Patel
The Patel Law Firm, P.C.
22952 Mill Creek Drive
Laguna Hills, California 92653

this 24th day of April, 2015.

/s/ John M. Nading

John M. Nading

Attorney for Petitioner